

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE T. CHIAPPE
and
RANDY W. GASQUOINE

Appeal No. 97-1754
Application 08/462,133¹

ON BRIEF

Before FRANKFORT, STAAB, and BAHR, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

¹ Application for patent filed June 5, 1995. According to appellants, this application is a continuation of Application 08/203,871, filed March 1, 1994; which is a continuation of Application 08/000,594, filed January 5, 1993; which is a continuation of Application 07/787,730, filed November 4, 1991; which is a continuation of Application 07/550,476, filed July 10, 1990 (now abandoned).

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DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 2 and 3, all the claims currently pending in the application. An amendment to the specification filed subsequent to the final rejection has been entered.

Appellants' invention pertains to an apparatus for regulating the flow of articles from an upstream work station to a downstream work station, and is said to be an improvement over appellants' earlier flow regulating apparatus disclosed in U.S. Patent No. 4,808,057. Claims 2 and 3, a copy of which is found in an appendix to appellants' main brief, define the appealed subject matter.

The references relied upon by the examiner as evidence of obviousness are:

Chiappe et al. (Chiappe)	4,808,057	Feb. 28, 1989
Murphy et al. (Murphy)	4,946,340	Sept. 30, 1988
Mojden et al. (Mojden)	4,979,870	May 18, 1988

Claims 2 and 3 stand rejected under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to

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particularly point out and distinctly claim the subject matter which applicant regards as the invention" (answer, page 3).

Claims 2 and 3 stand further rejected under 35 U.S.C. § 103 as being unpatentable over Chiappe in view of Murphy and Mojden.

The rejections are explained in the examiner's answer (Paper No. 40).

The opposing viewpoints of appellants are set forth in the main brief (Paper No. 39) and the reply brief (Paper No. 42).

The 35 U.S.C. § 103 Rejection

Considering first the standing § 103 rejection, for reasons stated *infra* in our treatment of the examiner's rejection of the appealed claims under 35 U.S.C. § 112, second paragraph, we have encountered considerable difficulty understanding the meaning of certain terminology appearing in appealed claim 2. Normally a claim which fails to comply with the second paragraph of § 112 will not be analyzed as to

whether it is patentable over the prior art since to do so would of necessity require speculation with regard to the metes and bounds of the claimed subject matter. *See In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Nevertheless, in the case of claim 2, we are of the opinion that the examiner's § 103 rejection cannot be sustained based on those portions of the claim that are understandable. Specifically, appealed claim 2 at lines 28-38² calls for

at least one pallet feeding assembly including a vertically extending elevator shaft perpendicularly intersecting the transfer station at a said storage placement and retrieval area, *said pallet feeding assembly further including an empty pallet staging area and a filled pallet staging area, each of said staging areas extending normally to the elevator shaft in spaced vertical relation to each other . . .* [Emphasis added.]

This arrangement is shown, for example, in appellants' Figures

² All references herein to line numbers for the appealed claims are with respect to the claims as they appear in the appendix to appellants' main brief.

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4 and 5, wherein in the center of each figure there is shown a vertical elevator shaft, and to the right thereof a pallet staging area comprising an upper storage area for empty pallets overlying a lower storage area for filled pallets.

Chiappe, the examiner's primary reference, is appellants' prior art jumping off point. With reference to Figure 1, Chiappe operates generally in the same manner as appellants' claimed apparatus in the sense that when the output flow of articles from upstream work stations 14-22 matches the demand for articles by downstream work stations 34a-34c, regulating apparatus 46 simply moves articles from inbound lanes 26a, 26b, etc. to outbound lanes 30a, 30b, etc. However, when the output flow of articles from the upstream work stations does not match the demand for articles by the downstream work stations, regulating apparatus functions to either (a) add extra articles to the flow of articles, as when downstream demand exceeds upstream supply, or (b) remove extra articles from the flow, as when downstream demand is less than upstream supply.

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Looking now at Figures 6 and 7 of Chiappe, groups of articles to be either added to or removed from the flow of articles are stored in trays 64. In particular, empty trays are stored to the right of the inbound and outbound lanes in empty tray magazine 50 and filled trays are stored to the left of the inbound and outbound lanes in filled tray magazine 52. Articles are loaded onto or removed from a tray 64 in deposit and retrieval area 51 by means of a transfer head. When there is a need to add articles to the flow and a tray 64 in area 51 becomes empty, it is moved to the right by a conveyor to magazine 50 and replaced by a filled tray from magazine 52. Conversely, when there is a need to remove articles from the flow and a tray 64 in area 51 becomes filled, it is moved to the left by the conveyor to magazine 52 and replaced by an empty tray from magazine 50. As is readily apparent from an inspection of Figure 6, the empty tray storage magazine 50 and the filled tray storage magazine 52 are not spaced in vertical relation to each other.

Murphy is directed to a parts unloading apparatus. A pallet of trays filled with articles enters the apparatus on

infeed conveyor 50 and is elevated by scissors lift 36 to an unloading station where the topmost tray is unloaded. The unloaded tray is then conveyed to an adjacent scissors lift 38 where it is temporarily stored. Thereafter, the next tray on the scissors lift 36 is elevated to the unloading station for unloading. As the process is repeated, filled trays are unloaded and transferred from lift 36 to lift 38. Eventually, scissors lift 38 is lowered and a pallet of empty trays leaves the apparatus via outfeed conveyor 60 for recycling. As is apparent from a review of Figure 2, the storage areas for filled and empty trays defined in part by scissors lifts 36 and 38 are not in spaced vertical relation to each other.

Mojden pertains to an apparatus for regulating the flow of articles from an upstream work station to a downstream work station. With reference to Figures 1 and 2, each and every one of the inbound articles from work station 25 is unloaded from inbound lanes onto trays 55, which trays when filled are transferred from empty tray stack table 60 to filled tray stack table 62. The stacks of filled trays are then conveyed

either directly by conveyor 40 to a similar unloading station on the opposite side of the apparatus for unloading articles onto outbound lanes, or to a storage area 41 to be held for use later as desired. As can be seen in Figure 2, storage areas defined in part by the empty tray stacking table 60 and the filled tray stacking table 62 are not in spaced vertical relation to each other.

In rejecting claim 2, the examiner has taken the position on page 4 of the answer that it would have been obvious "[t]o modify the apparatus of Chiappe et al so as to provide means to feed a pallet full of trays to the elevator area" in view of Murphy, and "[t]o modify the apparatus of Chiappe et al so as to move the transfer head, as claimed" in view of Mojden. However, even if it would have been obvious to one of ordinary skill in the art to modify Chiappe in the manner proposed by the examiner in light of the teachings of the secondary references, a *prima facie* case of obviousness would not ensue. This is so because none of the applied references discloses, suggests or implies an empty pallet staging area and a filled pallet staging area, each extending normally to the elevator

shaft in spaced vertical relation to each other, as called for in claim 2. On this basis alone the standing § 103 rejection of claim 2 cannot be sustained.

As to the standing § 103 rejection of claim 3, for reasons stated *infra* in our treatment of the examiner's rejection of the appealed claims under 35 U.S.C. § 112, second paragraph, we also have encountered considerable difficulty understanding the meaning of certain terminology appearing in appealed claim 3. However, in this instance, we do not understand the metes and bounds of the claimed subject matter sufficiently to be able to address the merits of the examiner's § 103 rejection. While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art, as we are obligated to do. Rejections based on 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." *In re Steele, supra*. When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does

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not become obvious, but rather the claim becomes indefinite. *In re Wilson, supra.* Accordingly, we are constrained to reverse the examiner's rejection of claim 3 under 35 U.S.C. § 103 on procedural grounds. We hasten to add that this reversal is not based upon any evaluation of the merits of the rejection. We take no position as to the pertinence of the prior art as applied by the examiner against claim 3.

The 35 U.S.C. § 112, Second Paragraph, Rejection

We agree with the examiner's bottom line determination that claims 2 and 3 do not comply with the second paragraph of 35 U.S.C. § 112. However, our reasons for so concluding differ substantially from those expressed by the examiner in the answer. Accordingly, we will affirm the decision of the examiner rejecting claims 2 and 3 under 35 U.S.C. § 112, second paragraph, but because of the altered thrust of our rationale in so doing, we will denominate said affirmance a new ground of rejection pursuant to our authority under 37 CFR § 1.196(b) in order to allow appellants a fair opportunity to response thereto.

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Looking first at the examiner's reasons for rejecting claims 2 and 3 under the second paragraph of § 112, we do not agree with the examiner that the claims are indefinite because no functional

language is associated with the term "storage container means" appearing in lines 24-25 of claim 2 and line 15 of claim 3. We are aware of no authority, and the examiner has cited none, that requires a function to be directly tied to the word "means" when the word "means" is used to claim an element of a claim, or that the failure to link a function with the word "means" violates the second paragraph of § 112.³ As to the examiner's contention that claim 3 is indefinite because there is no proper antecedent basis for the recitation in line 35 of "the same plane," for reasons explained *infra* we also have encountered difficulty in understanding the meaning of this term; however, our difficulty does not stem from that term's

³ However, mere incantation of the word "means" in a clause reciting predominately structure does not evoke the sixth paragraph of 35 U.S.C. § 112. See *York Prods. Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1623 (Fed. Cir 1996).

lack of a strict antecedent. Finally, as to the examiner's contention that lines 9 and 37 of claim 3 are confusing, appellants have not disputed the examiner's position in this regard. Rather, appellants merely state on page 1 of the reply brief that typographical errors appear in these lines, and that correction thereof would render the meaning of the claim clear. Since appellants have not disputed the examiner's position with respect to lines 9 and 37, we will summarily sustain the examiner's position that the meaning of lines 9 and 37 in claim 3 is not clear.

We now turn our attention to our own difficulties in understanding the meaning of claims 2 and 3. Considering first claim 2, lines 19-23 set forth "article group transfer means . . . for advancement downstream" and lines 23-28 set forth "means for transferring . . . to said outbound accumulator means." In that the disclosed reciprocating transfer head 24 appears to perform both the function called for in the "article group transfer means" limitation and the function called for in the "means for transferring" limitation, it is

not clear whether these "means" limitations are directed to different structures or to the same structure. Second, it appears that the term "storage container means" in lines 24-25 and the term "storage trays" in line 36 refer to the same element. Likewise, it appears that the "storage area" of line 24 and the "group-receiving storage areas" of line 37-38 refer to the same storage areas. If true, the use of multiple terms for the same elements is confusing and needlessly obscures the metes and bounds of the claim. On the other hand, if these terms do not refer to the same elements, the meaning of the claim is not clear. Third, in line 40, "the elevator shaft area" lacks a proper antecedent and it is not clear what this term refers to.

Turning to claim 3, lines 10-13 set forth "article group transfer means . . . for advancement downstream" and lines 13-18 set forth "means for transferring . . . downstream bound articles are accumulating." In that the disclosed reciprocating transfer head 24 appears to perform both the function called for in the "article group transfer means" limitation and the function called for in the "means for

transferring" limitation, it is not clear whether these "means" are directed to different structures or to the same structure. Second, "said area in which said articles are to be accumulated for advancement downstream" (lines 12-13) and "said inbound accumulating area" (lines 14-15) each lacks a proper antecedent and it is not clear what these terms refer to. Claim 3 is replete with additional terms that lack a proper antecedent. See, for example, "said inbound accumulator means" (lines 32-33), "said outbound accumulator means" (line 33), and "said article group receptacle areas" (line 34). Also, it is not clear whether "said transfer means" (line 20 and lines 33-34) refers to the "article group transfer means . . ." of lines

10-13, or to the "means for transferring . . ." of lines 13-18. In short, the lack of proper antecedent for numerous terms in claim 3 is confusing and needlessly obscures the metes and bounds thereof.⁴ Third, it is not clear what

⁴It is suggested that, in the event of further prosecution, the claims be checked for consistency of terminology.

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constitutes the "length dimension" of the inbound accumulator means, the outbound accumulator means, the transfer means, and the article group receptacle areas, nor what constitutes "the same plane" in which these elements "extend[] generally in," as called for in lines 32-35. Also, it not clear how these elements extend "generally parallel to each other" and "generally perpendicular with respect to" the transfer axis of the group transfer means, as called for in lines 36-39.

In light of the foregoing, we will affirm the examiner's decision rejecting claims 2 and 3 for failing to comply with the second paragraph of 35 U.S.C. § 112, with the proviso that our affirmance constitutes a new ground of rejection pursuant to 37 CFR § 1.196(b).

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Summary

The rejection of claims 2 and 3 under 35 U.S.C. § 103 is reversed *on the merits* with respect to claim 2 and on *procedural ground* with respect to claim 3.

The rejection of claims 2 and 3 under 35 U.S.C. § 112, second paragraph, is affirmed, *our affirmance being denominated a new ground of rejection pursuant to 37 CFR § 1.196(b).*

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner finally rejecting claims 2 and 3 is affirmed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997)), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that appellants *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of

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the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 1.196(b)

	CHARLES E. FRANKFORT)	
	Administrative Patent Judge)	
)	
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	LAWRENCE J. STAAB)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
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)	
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